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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,940	08/25/2003	Kenneth J. Brunelle		3453

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EXAMINER

LAYNO, BENJAMIN

ART UNIT PAPER NUMBER

3712

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/647,940	Applicant(s) BRUNELLE, KENNETH J.	
	Examiner Benjamin H. Layno	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>051404</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,446,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because the steps in the claims of the present invention are all recited in the steps of U.S. Patent No. 6,446,972. The only difference is that the steps are differently worded.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Lofink et al.

The patent to Lofink discloses a method of playing blackjack. To play Lofink's game each player places a main bet and each player optionally posting a side bet, col. 5, lines 44-47. Two cards are dealt to each player and the dealer, one face up and one face down, col. 5, lines 50-53. If the dealer's up card is a "2", this card is adopted as an activation card for bonus side bet play, col. 6, lines 33-35. If the player's first two cards are any holding, pair, pair of 2's, etc., these cards are adopted as a possible qualifying hand for bonus side bet play, col. 6, lines 35-51, and the player's side bet is resolved according to a bonus payout schedule, see Table 2. After the side bet is resolved a round of conventional blackjack is played, col. 3, lines 31-32.

In regard to claims 5 and 6, bonus play is activated if the dealer's up card is "2". Lofink does not recite dealer up card values of seven, eight, nine, ten, jack, queen, king or ace to activate bonus play, thus, these values do not activate bonus play.

Claim Rejections - 35 USC § 103

5. Claims 8-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Lofink et al.

In regard to claims 8 and 9, determining exactly what player two card combination to use to qualify for side bet bonus play (e.g. "Any Mixed Pair", "Any Suited Pair", "soft or hard seventeen", etc.) is simply a casino business decision which is always obvious in the art.

Concerning claim 10, Lofink teaches that the game is played on a table occupied by seven players, col. 6, lines 11-12. It is well known in the casino card gaming table art to provide player stations on the playing surface of the table for each player. It is also well known in the in casino card games that use main bets and side bets, to provide first betting spots for main bets, and second betting spots for side bets on each player station. In view of such teaching, it would have been obvious to incorporate player stations to Lofink's table. Each player station would have been provided with a first betting spot for main bets and a second betting spot for side bets.

In regard to the recitation in the last paragraph of claim 10 and the entire recitation in claims 11-20, Lofink discloses a bonus payout schedule "Table 2". The only difference between Lofink's bonus payout schedule and the claimed payout schedules recited in claims 10-20 reside in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore, the recitations in claims 10-20 referring to the payout schedules may be interpreted as game rules. In game apparatus claims, only the claimed elements having physical structure, (e.g. deck of playing cards, playing surface, player stations, etc.) are given patentable weight. Game rules, (e.g. "bonus payout values activated by the dealer's face up card", "bonus payout...will be awarded to a player", etc.), however, have no physical structure per se. Thus, game rules have no limiting affect in game apparatus claims.

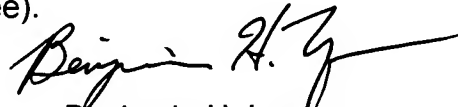
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Koelling discloses a blackjack game wherein the

value of the dealer's up card is adopted as possible activation cards for bonus side bet play, and player's first two cards are adopted as possible qualifying hand for bonus side play.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin H. Layno
Primary Examiner
Art Unit 3712

bhl